REMARKS

In this paper, claims 11-15 and 21-22 were amended and claims 23-27 added. Although these amendments are being submitted after final rejection, they are proper since they are accompanied by paperwork for filing a request for continued examination (RCE).

INTERVIEW SUMMARY

On August 27, 2007 an interview was conducted between Examiner Won and Attorney Dan Hubert (Reg. No. 33,906) at Applicant's request. Topics of discussion included shortcomings of the applied references, and various proposed language for amending and adding claims. No agreement was reached as to allowability of any claim.

CLAIM REJECTIONS - 35 USC 101

Claims 21-22 were rejected under 35 USC 101. The claims (as amended) satisfy the requirements of section 101.

CLAIM REJECTIONS - 35 USC 102

Claims 11-17 and 19-22 were rejected under 35 USC 102 as being anticipated by US 6,202,100 B1 ("Maltby"). The claims are patentable because the applied art does not teach the features of the claims (as amended).

Claim 11

Maltby is said to show a method where an object generated by a first application at a first computer in the network may be incorporated into a second application at a second computer in the network, via an operating system clipboard. [Maltby: col. 4, lines 33-40] However, Maltby's focus is on the protocol and other such mechanics of clipboard transfer. In this regard, Maltby focuses on technologies employing object linking and embedding (OLE) and dynamic data exchange (DDE). [Maltby: col. 4, line 33 - col. 6, line 45]

Maltby, however, lacks any concern with the user interface for replicating

the format and contents of an operating system clipboard. As to this aspect, Maltby is completely silent, or vague at best. Here are some examples:

- According to Maltby, because the CLIP SEND routine is a viewer of CLIPBOARD A, it is notified of any updates to CLIPBOARD A. When it is alerted to a change to CLIPBOARD A, it requests the list of available formats which it sends to CLIP RECEIVE. CLIP RECEIVE now takes ownership of CLIPBOARD B and inserts the list of formats using delayed rendering (i.e. it passes a null pointer to the operating system). [Maltby: col. 7, lines 30-50] According to this description, the clipboard send operation whenever there is a change to the clipboard, which teaches away from initiating clipboard transfer using an open IM window.

- According to another passage of Maltby, APPN A inserts data onto CLIPBOARD A using SetClipboardData (step 320). This causes a notification WM_DRAWCLIPBOARD to be sent to CLIP SEND (step 330). CLIP SEND interrogates CLIPBOARD A using EnumClipboardFormats (step 340) to obtain the list of formats in which the data on the clipboard is available. [Maltby: col. 7, lines 50-67; Fig. 3] According to this description, activity is triggered by APPN A inserting data onto CLIPBOARD A. However, there is no discussion of the means by which this is activated, relative to the user.

- According to Maltby, the user initially selects the clipboard entry corresponding to Object Embedding, either implicitly or explicitly, resulting in a GetClipboardData call from APPN B to CLIPBOARD B (step 410). [Maltby: col. 8, lines 8-30] However, Maltby does not explain how the user selects the clipboard entry. Further, the GetClipboardData call apparently occurs automatically from the user selection of the clipboard entry, negating the involvement of any user interface for this purpose.

Maltby, then, does not contain any meaningful disclosure of the user interface for effecting clipboard transfer.

In contrast to Maltby, claim 11 recites a specific details concerning the user interface for effecting clipboard transfer, and particularly, the use of IM

windows (of IM application programs running on first and second computers) to replicate content and format of the first computer's operating system clipboard in the operating system clipboard of the second computer. As to the user interface for clipboard transfer, Maltby is completely lacking as discussed above. And, as to the claimed use of IM windows in conjunction with clipboard replication among computers, Maltby is even more solidly lacking.

Maltby is said to show "conferencing software," but is vague as to what this means. In one passage, Maltby suggests that conferencing applications are "responsible for exchanging messages between the first and second computer." [Maltby: col. 6, lines 33-45] However, the stated exchange of messages between computers could be interpreted to mean virtually any type of communications between computers, e.g., IP packets, communications handshaking, video conferencing signals, etc. Consequently, this does not provide an enabling disclosure as to the claimed IM window (for displaying an exchange of text messages).

In another passage, Maltby suggests that an example of commercially available suitable conferencing software is Person to Person for Windows from IBM Corporation, which supports conferences between two or more people over a variety of communications links (e.g. LAN, ISDN, asynchronous). [Maltby: col. 7, lines 15-30] However, Maltby does not describe the structure or operation of the IBM product, which would likely be proprietary to IBM. Therefore, the meaning of Maltby's "conferencing software" is left to the user's imagination.

At any rate, Maltby does not describe the use of text messaging. And, quite plainly, Maltby does not take the further step of suggesting that the completion of clipboard transfer is related to the use of IM windows. In no case does Maltby teach that IM windows of IM application programs are used in replicating a clipboard from one computer to another.

For this reason, Maltby's disclosure is barren as to any of the specific user interface operations required out in claim 11:

- The first computer receiving a predetermined user input sequence including invocation of a predetermined clipboard paste command of the

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operating system running at the first computer, where the predetermined user input sequence is performed in conjunction with the IM window at the first computer.

- The IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer, the user prompt including notification that clipboard contents and format from the first computer are available to the second computer."

- The IM application program running on the second computer detecting user selection of the user prompt.

In view of the foregoing, Maltby does not teach the features of claim 11.

Claims 12-16, 18-19

These claims contain details that, further to the reasoning above, further define the claims from the applied art. However, there is no need to address the individual merits of these dependent claims. They are patentable simply because they depend from independent claim 11, which is allowable as discussed above.

Claim 20

This claim contains an alternative statement of the invention relative to claim 11. This claim is patentable for reasons analogous to those discussed above, and beyond this, for further reasons arising from specific language that contrasts with claim 11.

Claim 21

This claim is patentable for the same reasons as claim 11. This claim is a 'computer storage medium' counterpart to claim 11.

Claim 22

This claim is patentable for the same reasons as claim 20. This claim is a 'computer storage medium' counterpart to claim 20.

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Claims 23-24

These added, dependent claims contain details that, further to the reasoning above, further define the claims from the applied art. However, there is no need to address the individual merits of these dependent claims. They are patentable simply because they depend from independent claim 11, which is allowable as discussed above. These claims do not add any new matter, since they enjoy ample support throughout the original specification and drawings.

Claims 25-27

These claims were added to provide some alternate statements of the invention. These claims are patentable for reasons analogous to those discussed above, and beyond this, for further reasons arising from specific language that contrasts with claim 11. These claims do not add any new matter, since they enjoy ample support throughout the original specification and drawings.

CLAIM REJECTIONS - 35 USC 103

Claim 18 was rejected under 35 USC 103 as being obvious over Maltby as combined with US 2003/0221009 ("Standridge"). Even without considering the individual merits of this claim, it is patentably distinguished over the proposed combination because it depends from independent claim 11 (which is allowable over Maltby as discussed above), and Standridge fails to provide the features still missing from Maltby. In this regard, the office action introduced Standridge simply to show a user prompt comprising a hyperlink. [Office Action: page 11]

ADDITIONAL REFERENCES

Introduction

In a telephone discussion with Examiner Won on August 27, 2007, the Examiner mentioned two additional references. Apparently, these resulted from a computer-based word search using the terms "clipboard" and "instant

messaging." One is US Publication 2003/0120680 ("Agrawal") and the other is US Publication 2003/0221167 ("Goldstein").

Applicant wishes to cooperate in the examination of this application and help expedite processing of the application avoiding delay where possible. Therefore, although not required by the Rules, Applicant provides the following discussion to proactively emphasize the shortcomings of these references. Although the references may have met the Examiner's search criteria, their content fails to disclose Applicant's invention as claimed.

Incidental to the descriptions of Agrawal and Goldstein, each mentions some mechanism for populating a user's clipboard with a URL. Further, clipboard contents are purportedly sent to others using a technique such as instant messaging. Nonetheless, there are numerous deficiencies in Agrawal and Goldstein, such as the action of replicating the sender's clipboard contents in the recipient's clipboard, certain specifics of the instant messaging programs, and much more.

Agrawal

Agrawal recognizes that publishing content on a computer network (like the "web") can be expensive and difficult. [Agrawal: para. 0003] As part of Agrawal solution, Agrawal assigns a URL to the publisher's computer, which operates as a server to directly provide content and services. [Agrawal: para. 0012] Agrawal uses location-independent names that allow content requesters to be directed to desired content, resolving the dynamically assigned IP address problem. [Agrawal: para. 0011]

Agrawal discusses a specific process for a user to publish a file on a computer network. [Agrawal: para. 0030] The end result is that the user receives a URL pointing to the shared file. [Agrawal: para. 0030] Later, the user can self-publish the file by sharing the URL with others. In passing, Agrawal makes brief mention of a "clipboard" and "instant messaging," both incidental to Agrawal's self-publishing theme. Relatedly, Agrawal states that the URL can be copied to the clipboard, and subsequently shared with others by e-mail or instant

messaging. [Agrawal: para. 0030]

Agrawal discusses one shortcut for the user to copy the URL to the clipboard. Namely, a dialogue box with the resultant URL appears above a "copy to clipboard" button. Although not discussed by Agrawal, the "copy to clipboard" button presumably copies the URL into the user's clipboard, offering a minor convenience by avoiding user operations that would otherwise be required to enter the exhibited URL into the user's clipboard.

Ultimately, however, Agrawal's user manually shares the URL with others, such as by "e-mail or instant messaging." Relatedly, Agrawal does not contemplate anything other than use of standard e-mail or instant messaging. Agrawal does not propose any special techniques for using or modifying e-mail or instant messaging software.

Considering Agrawal in the context of claim 1 (as an example), Agrawal falls short of the claimed operation "the IM application programs automatically replicating contents and format of a clipboard provided by an operating system running at the first computer in a clipboard provided by an operating system running at the second computer."

For one, there is no discussion of replicating the sender's clipboard in the recipient's clipboard. At best, Agrawal might provide a text message (the URL) in the recipient's e-mail message or instant message, but there is no suggestion of replicating this in the recipient's clipboard. Obviously, then, there is no enabling disclosure of how Agrawal's text message might be replicated in the recipient's clipboard. Thus, Agrawal does not show "the IM application programs... replicating contents and format... in a clipboard provided by an operating system running at the second computer."

Furthermore, ignoring for the moment Agrawal's silence as to the recipient's clipboard, the clipboard operations relative to the sender are themselves lacking. Agrawal's only discussion of the technique for sharing the URL with others is merely: "e-mail or instant messaging." [Agrawal: para. 0030] Although Agrawal is silent on the matter, Applicant speculates that Agrawal's user might paste the URL (from the user's clipboard) as simple text into an e-mail

or instant message. As this is a user-performed act of manually transferring text of the clipboard, Agrawal does not teach "the IM application programs cooperatively replicating..."

Furthermore, as Agrawal does not elaborate on what it means to "share the URL with others via e-mail or instant messaging," Agrawal does not show the IM application programs replicating "format of a clipboard..." as claimed. One speculated meaning, simply pasting text into an instant messaging window, certainly falls short of replicating contents and format of a clipboard.

Furthermore, Agrawal does not show "the IM application program running on the second computer presenting a user prompt in conjunction with the IM window of the second computer, the user prompt including notification that clipboard contents and format from the first computer are available to the second computer" as claimed. Although Agrawal does provide any related explanation, Applicant speculates that to "share the URL with others via... instant messaging" would merely involve presenting clipboard text on the recipient's instant message screen. Hence, the required user prompt is lacking.

Goldstein

Goldstein's software is said to create an independent browser window, the custom selection window 34, containing only a relatively small toolbar, the window toolbar 36, and the custom selection of the content item 18 selected by the user. This allows the user to select and focus on desired content free from additional, and possibly distracting, content on the source page. [Goldstein: para. 0089] The custom selection window includes a link creation icon 130 which, when selected, loads or copies a hypertext link 132 for the associated custom selection window into the "clipboard" memory. [Goldstein: para. 0178] Goldstein's hypertext link 132, as with Agrawal, is preferably in the form of a URL. [Goldstein: para. 0178]

According to Goldstein, since the hypertext link 132 is loaded into clipboard memory, the user can "paste" the link 132 in an otherwise familiar manner into other documents or windows, such as the body of an e-mail

message or instant message. [Goldstein: para. 0179].

This discussion by Goldstein is largely cumulative to the disclosure of Agrawal. Analogous to Agrawal's dialogue box and "copy to clipboard" button, Goldstein's link creation icon 130 is merely a shortcut for copying the URL to the clipboard.

And ultimately, like Agrawal, Goldstein's user manually shares the URL with others such as by e-mail or instant message. [Goldstein: para. 0179] Goldstein does not propose any special techniques for using or modifying e-mail or instant messaging software. Indeed, Goldstein admits that this is accomplished "in an otherwise familiar manner." [Goldstein: para. 0179]

Goldstein, then, shares a number of features in common with Agrawal. And for similar reasons as Agrawal, Goldstein does not disclose the claimed features.

REQUEST FOR LEAVE TO ADD CLAIMS IN FUTURE

It is important for Applicant to have claims of varying scope, and further important to have counterpart claims drawn to different classes, such as a method and computer-readable medium. Nevertheless, Applicant is mindful of the Examiner's burden in examining a plurality of claims.

Consequently, Applicant has previously introduced placeholder claims, but voluntarily limited the addition of computer-readable medium type counterparts to the existing dependent claims. Applicant has suspended adding computer-readable medium claims corresponding to dependent method claims 12-19 and 23-26 pending an indication of allowable subject matter.

Applicants request generous leave to add new counterpart claims upon an indication of allowable subject matter, by Rule 312 amendment or other appropriate means.

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The Commissioner is authorized to charge $600 for three (3) additional independent claims, and any additional fees due, to the Glenn Patent Group Deposit Account No. 07-1445, Customer No. 22862.

Respectfully Submitted,

Michael Glenn
Reg. No. 30,176

Customer 22,862

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